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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/629,370	07/31/2000	Jason Sulak	18/05085742	5426

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TUCKER, ELLIS & WEST LLP
1150 HUNTINGTON BUILDING
925 EUCLID AVENUE
CLEVELAND, OH 44115-1475

EXAMINER

PILLAI, NAMITHA

ART UNIT	PAPER NUMBER
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2173

DATE MAILED: 05/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/629,370

Applicant(s)

SULAK ET AL.

Examiner

Namitha Pillai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 8-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 8-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claim 10 is rejected for reciting the limitation "a printable product" in addition to the reference to "a printable product" later in the same claim 11 (line 8). There is insufficient antecedent basis for this limitation in the claims. It is not clear whether the "printable product" referred to in line 8 refers to a new printable product or the earlier one recited in the preamble of claim 10.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-5 and 8-26 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by U. S. Patent No. 6, 704, 120 B1 (Leone III et al.), herein referred to as Leone.

Referring to claim 1, Leone discloses a system for on-line creation of a printable product (column 4, lines 15-45). Leone discloses a server accessible via a computer network, for storing defining data defining a plurality of printable products including one or more design elements (column 4, lines 41-46). Leone discloses a first program providing a user with modification

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functions for modifying the defining data, and assembly functions for assembling a printable product suitable for printing (column 4, lines 41-51). Leone discloses a client computer for accessing the server, wherein the server downloads the first program and the defining data to the client computers (Figure 2 and column 6, lines 37-40). Leone discloses a printer operatively coupled with the client computer, wherein the first program assembles printing data for printing the printable product on the printer (Figure 2 and column 4, lines 47-51).

Referring to claims 2 and 15, Leone discloses that the plurality of printable products includes banners, business cards, calendars, greeting cards, certificates, craft cards, envelopes, invitations and message cards (column 4, lines 58-66 and column 5, lines 1-2).

Referring to claims 3 and 16, Leone discloses that the client computer includes a browser program for accessing the web server, wherein the first program enhances the functionality of the browser program (column 8, lines 49-53).

Referring to claims 4 and 17, Leone discloses that the first program controls the downloading to the client computer of the defining data that defines a selected printable product (column 8, lines 21-24), wherein the first program downloads defining data represented as Java class wherein the defining data refers to the operation information for customizing the images of the printable product.

Referring to claims 5 and 18, Leone discloses that defining data defines graphical elements, text elements, and formatting data associated with the graphical and text elements (column 5, lines 3-42).

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Referring to claims 8 and 20, Leone discloses that the assembly of printing data includes resizing, scaling, division into panels that anticipate printing in a desired printing format (column 7, lines 33-55).

Referring to claims 9 and 21, Leone discloses modification function of the first program includes modification to color, adding a design element, and deleting a design element (column 7, lines 65-67 and column 8, lines 46-59).

Referring to claim 10, Leone discloses means for creating, modifying and printing of a printable product (column 1, lines 8-11). Leone discloses means for downloading data defining a printable product, modifying a browser program on a personal computer of a user to allow the user to edit the data defining a printable product within the browser program (column 8, lines 49-53). Leone discloses modifying the defining data and formatting the defining data for printing (column 4, lines 22-28).

Referring to claim 11, Leone discloses manipulating one or more design elements (column 4, lines 27-29).

Referring to claim 12, Leone discloses that design elements include text and graphics (column 5, lines 3-11).

Referring to claim 13, Leone discloses print formatting includes resizing, scaling, and division into panels associated with a fold format (column 7, lines 33-55).

Referring to claim 14, Leone discloses a method for generating a printable product using an online system accessible via a computer network (column 8, lines 49-53). Leone discloses storing on a server accessible via the computer network, data defining a plurality of printable products including one or more design elements (column 6, lines 62-65). Leone discloses storing

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on the server a first program to enhance the functionality of a web browser program by providing a user with modification functions for modifying the defining data (column 8, lines 49-53).

Leone discloses assembly functions for assembling a printable product suitable for printing, wherein the assembly and modification functions occur within the web browser program on a client computer (column 8, lines 49-53). Leone discloses downloading the first program to the client computer accessing the server through the web browser program, to provide for the user modification and printing of a printable product at the client computer (column 8, lines 49-53). Leone discloses printing the printable product on a printer operatively coupled to the client computer (Figure 2 and column 6, lines 48-50).

Referring to claim 19, Leone discloses using the first program to assemble printing data for printing the printable product on the printer (column 8, lines 46-53).

Referring to claim 22, Leone discloses a system for enabling a user to create and print a social expression product over a computer network (column 8, lines 49-53). Leone discloses a web server, a personal computer of the user having means for communicating with the web server over the computer network (column 7, lines 62-65). Leone discloses a web browser located on the personal computer of the user, a database storing defining data defining a plurality of printable products including one or more design elements, the database communicatively coupled to the web server (Figure 2, column 6, lines 62-65 and column 7, lines 62-65). Leone discloses a plug-in program stored on the web server and downloaded to the web browser loaded on the personal computer of the user, the plug-in program providing the user with means for retrieving defining data from the database, means for modifying the retrieved defining data and means for assembling a social expression product on the personal computer of the user

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(column 8, lines 16-60). Leone discloses a printer operatively coupled to the personal computer of the user, wherein the user is able to print a social expression product at the personal computer of the user (Figure 2 and column 6, lines 44-51).

Referring to claim 23, Leone discloses a system for enabling a user to create and print a social expression product over a computer network (column 8, lines 49-53). Leone discloses a web server, a personal computer of the user having means for communicating with the web server over the computer network (column 7, lines 62-65). Leone discloses a web browser located on the personal computer of the user, a storage device containing defining data defining a plurality of printable products including one or more design elements (column 6, lines 62-65). Leone discloses a plug-in program stored on the web server and downloaded to the web browser loaded on the personal computer of the user, the plug-in program providing the user with means for retrieving defining data, means for modifying the retrieved defining data and means for assembling a social expression product on the personal computer of the user (column 8, lines 16-60). Leone discloses a printer operatively coupled to the personal computer of the user, wherein the user is able to print a social expression product at the personal computer of the user (Figure 2 and column 6, lines 44-51).

Referring to claim 24, Leone discloses that the storage device is one of a group consisting of a remote storage device, a web server, a personal computer, and a storage medium (Figure 2).

Referring to claim 25, Leone discloses that the plug-in program further provides the user with means for adding design elements from an external source, the added design elements created by the user (column 5, lines 47-67).

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Referring to claim 26, Leone discloses data defining a printable product is stored on one of a group consisting of a remote storage device, a personal computer, and a portable storage medium (column 6, lines 62-67).

Response to Claim Changes

3. The Examiner acknowledges Applicant's amendment to claim 10 to better specify the claimed invention. However, all claims are rejected as being previously disclosed based on prior art suggested by the Appeals Board and further searching performed by Examiner.

Response to Arguments

4. In view of the decision on the appeal filed on 1/14/04, PROSECUTION IS HEREBY REOPENED. The Appeals board has reversed the prior rejections and arguments wherein references Rhoads, Cannon and Gennaro were used in combination. Further searching and prior art suggested by the Appeals Board has been considered in forming the current rejection, wherein claims 1-5 and 8-26 are not allowable as a result of being previously disclosed in prior art.

Conclusion

5. The prior art made of record on form PTO-892 and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 C.F.R. § 1.111(c) to consider these references fully when responding to this action. The documents cited therein teach the method for online creation of a social greeting document.

Responses to this action should be mailed to: Commissioner of Patents and

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Trademarks, Washington D.C. 20231. If applicant desires to fax a response, central FAX number (703) 872-9306 may be used. NOTE: A Request for Continuation (Rule 60 or 62) cannot be faxed.

Please label "PROPOSED" or "DRAFT" for informal facsimile communications. For after final responses, please label "AFTER FINAL" or "EXPEDITED PROCEDURE" on the document. Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

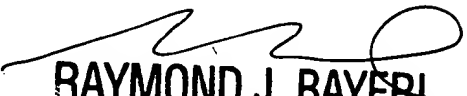
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Namitha Pillai whose telephone number is (571) 272-4054. The examiner can normally be reached on 8:30 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca can be reached on (571) 272-4048.

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3800.

Namitha Pillai
Assistant Examiner
Art Unit 2173
April 29, 2005


RAYMOND J. BAYERL
PRIMARY EXAMINER
ART UNIT 2173